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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/527,470	03/20/2006	Henry Chiu	P1976R1	2152

9157 7590 10/31/2007  
GENENTECH, INC.  
1 DNA WAY  
SOUTH SAN FRANCISCO, CA 94080

EXAMINER
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STOICA, ELLY GERALD

ART UNIT	PAPER NUMBER
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1647

MAIL DATE	DELIVERY MODE
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10/31/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/527,470	<b>Applicant(s)</b> CHIU ET AL.	
	<b>Examiner</b> Elly-Gerald Stoica	<b>Art Unit</b> 1647	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-28 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claims 1-8, drawn to an isolated nucleic acid.

Group II, claims 9-11, drawn to a polypeptide.

Group III, claims 12-13, drawn to an antibody.

Group IV, claims 14-17 drawn to a composition of matter.

Group V, claims 18-19, drawn to a method of treating a B cell related disease.

Group VI, claim 20, drawn to a method of detection of a polypeptide.

Group VII, claims 21 and 28, drawn to a method of diagnosis based on the gene expression level.

Group VIII, claim 22, drawn to a method of diagnosis based on the use of antibodies.

Group IX, claim 23, drawn to a method of detection of an activity inhibitor of a protein.

Group X, claims 24 and 25, drawn to a method of detection of a gene repressor.

Group XI, claim 26, drawn to a method of detection of an agonist analogue of a protein.

Group XII, claim 27, drawn to a method of stimulation of a B cell response.

2. The inventions listed as Groups I-XII do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or

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corresponding special technical features for the following reasons: nucleic acid claimed in Claim I were known in the art (e.g. Ochiai et al, NCBI accession number BAB40337, Human Mail, April 3, 2001).

3. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

If Applicant elects Invention I, the species are: Seq. Id. No.: 1-27.

If Applicant elects Invention II or III, the species are: Seq. Id. No.: 2, 4, 6, 10, 12, 14, 16, 19, 21, 24.

If Applicant elects Invention IV there are two categories of species:

A) Peptides: Seq. Id. No.: 2, 4, 6, 10, 12, 14, 16, 19, 21, 24.

B) Active components: a polypeptide, an agonist of a polypeptide, an antagonist of a polypeptide, an antibody that binds to a polypeptide.

If Applicant elects invention V, there are three categories of species:

A) Peptides: Seq. Id. No.: 2, 4, 6, 10, 12, 14, 16, 19, 21, 24.

B) Active components: a polypeptide, an agonist of a polypeptide, an antagonist of a polypeptide, an antibody that binds to a polypeptide.

C) Diseases: systemic lupus erythematosus, X-linked infantile hypogammaglobulinemia, polysaccharide antigen unresponsiveness, selective IgA deficiency, selective IgM deficiency, selective deficiency of IgG subclasses, immunodeficiency with hyper Ig-M, transient hypogammaglobulinemia of infancy, Burkitt's lymphoma, Intermediate lymphoma, follicular lymphoma, type II

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hypersensitivity, rheumatoid arthritis, autoimmune mediated hemolytic anemia, myasthenia gravis, hypoadrenocorticism, glomerulonephritis and ankylosing spondylitis.

If Applicant elects any of the Inventions VI-XII, the species are: PRO52040, PRO71035, PRO52892, PRO52174, PRO71207, PRO71288, PRO71210, PRO71289, PRO52268 or PRO52672.

Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The election has to be made depending of the Invention elected, so as **if the Invention contains multiple categories of species, a specie from each category should be elected.** The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

4. The claims are deemed to correspond to the species listed above in the following manner:

Claims 1-8: Seq. Id. No.: 1-27.

Claims 9-19: Seq. Id. No.: 2, 4, 6, 10, 12, 14, 16, 19, 21, 24.

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Claims 14-19: a polypeptide, an agonist of a polypeptide, an antagonist of a polypeptide, an antibody that binds to a polypeptide.

Claims 18-19: systemic lupus erythematosus, X-linked infantile hypogammaglobulinemia, polysaccharide antigen unresponsiveness, selective IgA deficiency, selective IgM deficiency, selective deficiency of IgG subclasses, immunodeficiency with hyper Ig-M, transient hypogammaglobulinemia of infancy, Burkitt's lymphoma, Intermediate lymphoma, follicular lymphoma, type II hypersensitivity, rheumatoid arthritis, autoimmune mediated hemolytic anemia, myasthenia gravis, hypoadrenocorticism, glomerulonephritis and ankylosing spondylitis.

Claims 20-28: PRO52040, PRO71035, PRO52892, PRO52174, PRO71207, PRO71288, PRO71210, PRO71289, PRO52268 or PRO52672.

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: they have different structure and have different properties or represent different diseases.

6.

Applicant is advised that the reply to this requirement to be complete must include (i) an election of a species or invention to be examined even though the requirement be traversed (37 CFR 1.143) and (ii) identification of the claims encompassing the elected invention.

The election of an invention or species may be made with or without traverse. To reserve a right to petition, the election must be made with traverse. If the reply does not

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distinctly and specifically point out supposed errors in the restriction requirement, the election shall be treated as an election without traverse.

Should applicant traverse on the ground that the inventions or species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions or species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C.103 (a) of the other invention.

7. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

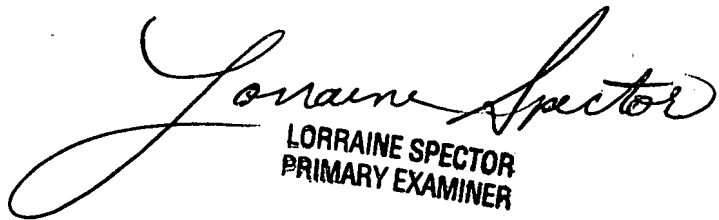
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elly-Gerald Stoica whose telephone number is (571) 272-9941. The examiner can normally be reached on 8:30-17:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Manjunath N. Rao can be reached on (571) 272-0939. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for

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published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



LORRAINE SPECTOR  
PRIMARY EXAMINER